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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/708,475	11/09/2000	Joseph T. Strupczewski	2489.0028-12	7075

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EXAMINER
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COLEMAN, BRENDA LIBBY

ART UNIT	PAPER NUMBER
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1624

DATE MAILED: 05/27/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.  
**09/708,475**

Applicant(s)  
**STRUPCZEWSKI et al.**

Examiner  
**Brenda Coleman**

Art Unit  
**1624**



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Mar 5, 2003
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-48, 50-56, and 58-115 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 25-28, 32, 46-48, 50-56, and 58-115 is/are allowed.
- 6) ☒ Claim(s) 1-13, 29-31, and 33-45 is/are rejected.
- 7) ☒ Claim(s) 14-24 is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 6) ☐ Other:

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### **DETAILED ACTION**

Claims 1-48, 50-56 and 58-115 are pending in the application.

This action is in response to applicant's amendment filed March 5, 2003. Claims 1, 9, 25, 27, 29-33, 37, 46, 54, 66, 74, 86-89, 92, 93 and 104 have been amended.

#### ***Response to Amendment***

Applicant's arguments filed March 5, 2003 have been fully considered with the following effect:

1. The original patent, or an affidavit or declaration as to loss or inaccessibility of the original patent, must be received before this reissue application can be allowed. See 37 CFR 1.178.
2. The applicants' amendment and arguments are sufficient to overcome the 35 U.S.C. § 103, obviousness rejection of claims 1-6, 10-13, 30, 35, 44 and 45 maintained in the last office action which is hereby **withdrawn**.
3. The applicants' amendment and arguments are sufficient to overcome the 35 U.S.C. § 112, second paragraph rejections of the last office action which are hereby **withdrawn**.

In view of the amendment dated March 5, 2003, the following new grounds of rejection apply:

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-13, 29-31 and 33-45 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The following reasons apply:

- a) Claim 1 (and claims dependent thereon) includes an "or" in the definition of X which does not appear in claim 25 of U.S. 5,658,911. Any insertions into the text of the original claims must be underlined.

§ 1.121 Manner of making amendments.

(a) Erasures, additions, insertions, or alterations of the Office file of papers and records must not be physically entered by the applicant. Amendments to the application (excluding the claims) are made by filing a paper (which should conform to § 1.52) directing or requesting that specified amendments be made. The exact word or words to be stricken out or inserted by said amendment must be specified and the precise point indicated where the deletion or insertion is to be made.

(b) Except as otherwise provided herein, a particular claim may be amended only by directions to cancel or by rewriting such claim with underlining below the word or words added and brackets around the word or words deleted. The rewriting of a claim in this form will be construed as directing the cancellation of the original claim; however, the original claim number followed by the parenthetical word "amended" must be used for the rewritten claim. If a previously rewritten claim is rewritten, underlining and bracketing will be applied in reference to the previously rewritten claim with the parenthetical expression "twice amended," "three times amended," etc., following the original claim number.

(c) A particular claim may be amended in the manner indicated for the application in paragraph (a) of this section to the extent of corrections in spelling, punctuation, and typographical errors. Additional amendments in this manner will be admitted provided the changes are limited to (1) deletions and/or (2) the addition of no more than five words in any one claim. Any amendment submitted with instructions to amend particular claims but failing to conform to the provisions of paragraphs (b) and (c) of this section may be considered nonresponsive and treated accordingly.

(d) Where underlining or brackets are intended to appear in the printed patent or are properly part of the claimed material and not intended as symbolic of changes in the particular claim, amendment by rewriting in accordance with paragraph (b) of this section shall be prohibited.

(e) In reissue applications, both the descriptive portion and the claims are to be amended by either (1) submitting a copy of a portion of the description or an entire claim with all matter to be

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deleted from the patent being placed between brackets and all matter to be added to the patent being underlined, or (2) indicating the **exact word** or words to be stricken out or inserted and the precise point where the deletion or insertion is to be made. Any word or words to be inserted must be underlined. See § 1.173.

(f) Proposed amendments presented in patents involved in reexamination proceedings must be presented in the form of a full copy of the text of: (1) Each claim which is amended and (2) each paragraph of the description which is amended. Matter deleted from the patent shall be placed between brackets and matter added shall be underlined. Copies of the printed claims from the patent may be used with any additions being indicated by carets and deleted material being placed between brackets. Claims must not be renumbered and the numbering of the claims added for reexamination must follow the number of the highest numbered patent claim. No amendment may enlarge the scope of the claims of the patent. No new matter may be introduced into the patent.

- b) Claim 1 (and claims dependent thereon) is missing a comma after the number 4 in the definition of n, which appears in claim 1 of U.S. 5,658,911. Any deletions from the original claims must be made with brackets.
- c) Claim 1 (and claims dependent thereon) is missing a comma after "optical" in the second from the last line of the claim, which appears in claim 1 of U.S. 5,658,911.
- d) Claim 29 (and claims dependent thereon) are vague and indefinite in that it is not known what is meant by the second occurrence of "F, Br, I, amino, C<sub>1</sub>-C<sub>3</sub> mono- or dialkylamino, acylamino, -NO<sub>2</sub>, -OCF<sub>3</sub>, which appears at the bottom of page 10 and again at the top of page 11 of the amendment.
- e) Claim 30 is missing a comma after the number 4 in the definition of n, which appears in claim 30 of U.S. 5,658,911.
- f) Claim 30 includes a letter "H" in the definition of R<sub>21</sub> in the first moiety, i.e. -CH<sub>2</sub>-CH=CH-CH<sub>2</sub>- which does not appear in claim 30 of U.S. 5,658,911.

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- g) Claim 30 includes a letter “e” in the definition of  $R_{20}$  and  $R_{21}$  at the end of the word “one” which does not appear in claim 30 of U.S. 5,658,911.
- h) Claim 30 is missing a comma after “optical” in the second from the last line of the claim, which appears in claim 30 of U.S. 5,658,911.
- i) Claim 31 is missing a comma after the number 4 in the definition of  $n$ , which appears in claim 31 of U.S. 5,658,911.
- j) Claim 31 includes a letter “e” in the definition of  $R_{20}$  and  $R_{21}$  at the end of the word “one” which does not appear in claim 31 of U.S. 5,658,911.
- k) Claim 31 is missing a comma after “optical” in the second from the last line of the claim, which appears in claim 31 of U.S. 5,658,911.
- l) Claim 33 (and claims dependent thereon) is missing a semicolon after the phenyl ring which is substituted by  $(Z_1)_p$  in the claim, which appears in claim 33 of U.S. 5,658,911.

### ***Claim Objections***

5. Claims 14-24 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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*Allowable Subject Matter*

6. Claims 25-28, 32, 46-48, 50-56 and 58-115 are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brenda Coleman whose telephone number is (703) 305-1880. The examiner can normally be reached on Mondays and Tuesdays from 9:00 AM to 3:00 PM and from 5:30 PM to 7:30 PM and on Wednesday thru Friday from 9:00 AM to 6:00 PM.

The fax phone number for this Group is (703) 308-4734 for "unofficial" purposes and the actual number for **OFFICIAL** business is **308-4556**.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1235.



Brenda Coleman  
Primary Examiner AU 1624  
May 26, 2003